

## **REMARKS**

### **I. Status of the Claims**

Claims 1-33 were originally filed. Claims 34 and 35 were later added. As the result of a restriction requirement, claims 1-21, 34, and 35 were elected and claims 22-33 were canceled. Upon entry of the present amendment, claim 2 is canceled. Claim 1 recites the limitations previously presented in claim 2. Claim 1 also recites the full name for ADNF, activity dependent neurotrophic factor, which finds support in the specification, *e.g.*, on page 9, lines 17-18. Claims 7, 11, and 15 are amended to delete the word "about" before "20 amino acids." Claim 16 is amended to improve clarity of the claim language and to ensure proper claim antecedent basis. No new matter is introduced.

### **II. Sequence Listing**

In response to the Examiner's objections, a computer readable form of sequence listing is provided with this response. Corresponding amendment is made to the specification.

### **III. Claim Objections**

Claims 1-21, 34, and 35 are objected to for reciting the term "ADNF" without first giving its full name. Claim 16 is objected to for alleged failure to further limit the claim scope from claim 2, from which claim 16 depends. As amended, claim 1 now recites the full name of "ADNF" and claim 16 now recites that "administration of the ADNF polypeptide is achieved by administering a nucleic acid encoding the ADNF polypeptide to the subject." This amended language of claim 16 indeed further limits the claim scope from claim 2, where the ADNF polypeptide could be administered by different means: for example, by administration of the polypeptide directly or by administration of a nucleic acid encoding the polypeptide. The objections are thus overcome.

### **IV. Claim Rejections**

#### **A. 35 U.S.C. §112, Second Paragraph**

Claims 3, 4, 7, 8, 11, 12, and 15 are rejected under 35 U.S.C. §112, second paragraph, for alleged indefiniteness. Specifically, the Examiner contends that the use of

"ADNF I" and "ADNF III" as limitations does not allow one to determine the precise metes and bounds of these terms. The Examiner also points to the language "up to about 20 amino acids" in claims 7, 11, and 15 for allegedly being vague and indefinite.

In response, claim 1 has been amended to include the limitations previously recited in claim 2, which is now canceled. As such, each of the "ADNF I" and "ADNF III" polypeptides is clearly defined by the presence of a distinct core sequence. Any possible ambiguity associated with the use of these terms is eliminated. On the other hand, claims 7, 11, and 15 have been amended to remove the word "about." Applicants therefore submit that the amended claims no longer present any issue with indefiniteness.

Withdrawal of the rejections under 35 U.S.C. §112, second paragraph, are respectfully requested.

**B. 35 U.S.C. §112, First Paragraph**

Claims 1, 16-21, 34, and 35 are rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement. Since the Examiner apparently has acknowledged the proper enablement of the claimed subject matter as defined by original claim 2, now canceled and replaced by amended claim 1 in identical scope, Applicants submit that the enablement rejection is overcome in view of the present claim amendment.

Withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is respectfully requested.

**C. Double Patenting**

Claims 1-15, 17-21, 34, and 35 are rejected under the judicially created doctrine of obviousness type double patenting over the claims of U.S. Patent No. 6,933,277. Without acquiescing to the Examiner's position, Applicants hereby submit a terminal disclaimer disclaiming the patent term beyond that of U.S. Patent No. 6,933,277. The double patenting rejection is therefore overcome.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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